

### REMARKS

Claims 1, 7, 9-10, 12 and 15-25 have been canceled.

Claims 2, 4-6, 8, 11, 13 and 26-27 have been amended.

Claims 2-6, 8, 11, 13-14 and 26-27 are pending.

### **Election/Restrictions**

The First Office Action required a restriction of one of the following inventions under 35 U.S.C. 121:

- I. Claim 21 is drawn to the combination of a brace comprising a temperature pad.
- II. Claims 1-20 and 22-25 are drawn to the subcombination of a brace comprising a thermally conductive sheet, a temperature controller or a temperature control circuit.

The Office Action stated that the inventions are distinct because the inventions of Group I and Group II are related as combination and subcombination. The Office Action further states that the inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP 806.05©). In the instant case, the combination as claimed does not require the particulars of the

subcombination as claimed because the claims of the subcombination require either a thermally conductive sheet, a temperature controller, or a temperature control circuit. The subcombination has a separate utility such as temperature regulating devices.

Furthermore, if Application chooses group II, Applicant is required to further elect between the subcombinations as defined below.

- III. Claims 1-14, drawn to an orthopaedic brace comprising a thermally conductive sheet, classified in class 219, subclass 529.
- IV. Claims 15-20, drawn to a back brace comprising a temperature pas and a temperature controller, classified in class 2, subclass 92.
- V. Claim 22, drawn to a self-contained heating and cooling kit, classified in class 62, subclass 3.5.
- VI. Claims 23-25, drawn to a temperature control circuit, classified in class 62, subclass 98.

The Office Action states that the inventions of Group III, Group IV, Group V and Group VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the invention of the subcombination has a separate utility such as follows. Group III can be used as an electric blanket or warming pad. Group IV can be used as a body comforter or back

protector. Group V can be used as a device which uses an electrical effect to produce both a heating and cooling treatment such as a flexible heat exchanger material. Group VI can be used as a device which supplies an electrical current in a localized manner such as a temperature control circuit in a circulation warmer.

Through a telephonic communication on November 9, Attorney for Applicant Greg O'Bradovich provisionally elected Group III, Claims 1-14 with traverse.

Applicant respectfully notes that Examiner did not make a final determination that the restriction is proper or improper in response to Applicant's traverse. However, in order to prevent delays in allowance, Applicant has canceled the non-elected Claims 15-25.

### **Allowable Subject Matter**

The Office Action indicated that Claims 2, 3, 13 and 14 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant has rewritten Claims 2 and 13 into independent form and submits that Claims 2 and 13 are now allowable. Claims 3-6 depend from Claim 2 and are also deemed allowable. Claims 8, 11, 14 and 26-27 depend from Claim 13 and are also deemed allowable.

## Claim Rejections

### 35 U.S.C. §103

The Office Action rejected Claims 1, 4, 5, 6, 26 and 27 under 35 U.S.C. 103(a) as being unpatentable over Taylor (US Patent No. 6,125,636) in view of Altura (US Patent No. 6,613,953) or Haas (US Patent No. 6,074,414). Applicant submits that the rejection is moot because Claim 1 has been canceled, Claims 4-6 depend from allowable Claim 2 and Claims 26 and 27 depend from allowable Claims 13.

The Office Action rejected Claims 7, 8 and 11 under 35 U.S.C. 103(a) as being unpatentable over Brink (US Patent No. 5,741,220) in view of Brunswick (US Patent No. 4,716,892) and Dvoretzky et al (US Patent No. 5,534,021). Applicant submits that the rejection is moot because Claim 7 has been canceled and Claims 8 and 11 now depend from allowable Claim 13.

If Examiner has any questions regarding this document, Applicant asks that Examiner contact the undersigned immediately by telephone.

Respectfully submitted,



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